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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,083	10/16/2003	Ibrahim Sendijarevic	TRPI 0103 PUSP	9091

22045 7590 02/08/2005

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER	
PATTERSON, MARC A	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/687,083	SENDIJAREVIC ET AL.	
	Examiner	Art Unit	
	Marc A Patterson	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-15 is/are rejected.

7)☒ Claim(s) 2 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1/23/04, 2/3/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1 – 15, drawn to a protective packaging, classified in class 428, subclass 36.5.

   II. Claims 16 – 25, drawn to a method of producing a protective packaging, classified in class 53, subclass 397.

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of using the product, such as conforming the shape memory foam to an article without placing the article and foam into a container.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Matthew Jakubowski on January 29, 2005, a provisional election was made with traverse to prosecute the invention of I, claims 1 – 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims

16 – 25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claim 2 is objected to because of the following informalities: The meaning of the phrase 'deformed or compressed above the T_g to produce a compressed shape' is unclear because it is unclear what deformation produces the compressed shape. For purposes of examination, the phrase will be interpreted to mean 'deformed or compressed above the T_g to produce a deformed or compressed shape.' Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 – 9 and 11 – 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 24 of U.S. Patent No. 6,583,194 in view of Malwitz (U.S. Patent No. 4,654,375). Although the conflicting claims are not identical, they are not patentably distinct because Malwitz teaches the use of polyurethane

foam (column 1, lines 33 – 37) which comprises a synthetic additive (fire retardant additive; column 4, lines 2 – 3) and is at least partially coated in a film (Malwitz teaches the interchangeable use of polyurethane as a foam and coating and therefore teaches a foam which is partially coated, therefore partially coated with a film; column 43 – 46) as a packaging material that is protective (column 1, lines 33 – 37) for the purpose of obtaining a packaging material that provides cushioning ability (column 1, lines 33 – 37). It would therefore have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a protective packaging material comprising the polyurethane having a glass transition temperature of above 21 degrees Celsius in order to provide for a packaging material that provides cushioning ability as taught by Malwitz.

7. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 24 of U.S. Patent No. 6,583,194 in view of Malwitz (U.S. Patent No. 4,654,375) and Krishnan et al (U.S. Patent No. 5,306,319).

Although the conflicting claims are not identical, they are not patentably distinct because Krishnan et al teach the selection of glass transition temperature of an organic matrix depending on the desired rigidity or flexibility (column 1, lines 8 – 12). Therefore, one of ordinary skill in the art would have recognized the utility of varying the glass transition temperature of the polyurethane, which is an organic matrix, to obtain the desired rigidity or flexibility. Therefore, the rigidity or flexibility would be readily determined by through routine optimization of the glass transition temperature by one having ordinary skill in the art depending on the desired use of the end product as taught by Krishnan et al. It therefore would be obvious for one of ordinary

skill in the art to vary the glass transition temperature in order to obtain the desired rigidity or flexibility, since the rigidity or flexibility would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Krishnan et al.

8. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,583,194 in view of Malwitz (U.S. Patent No. 4,654,375) and McKillip et al (U.S. Patent No. 3,432,475).

Although the conflicting claims are not identical, they are not patentably distinct because McKillip et al teach the use of a radiation resistant polyurethane (column 1, lines 20 – 23) for the purpose of obtaining polyurethanes having reduced degradation (column 6, lines 57 – 62). It therefore would have been obvious for one of ordinary skill in the art to provide for the radiation resistance of McKillip et al in the polyurethane foam in order to provide a polyurethane having reduced degradation as taught by McKillip et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 2/5/05
Marc A. Patterson, PhD.
Examiner
Art Unit 1772